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| 09/156,952 | 09/18/1998 | ROY A. OSTGAARD | CYM-025 | 1770 |

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EXAMINER

BEX, PATRICIA K

ART UNIT

PAPER NUMBER

1743

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 40

Application Number: 09/156,952
Filing Date: September 18, 1998
Appellant(s): OSTGAARD ET AL.

David T. Burse
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 10, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

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(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1-8, 10, 12-26 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

| | | |
|-----------|---------|--------|
| 5,894,733 | BRODNER | 4-1999 |
|-----------|---------|--------|

| | | |
|-----------|-------|--------|
| 5,855,289 | MOORE | 1-1999 |
|-----------|-------|--------|

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

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obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-8, 10, 12-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brodner (USP 5,894,733) in view of Moore (USP 5,855,289).

Brodner teaches the use of polypropylene (column 3, lines 11-13) combination 14 sample vial comprising a sleeve 12 and inner container 10. The combination having an outer surface 55, an open end and closed bottom end (Fig. 2). The vial combination comprising a plurality of integral anti-rotation lugs 56 about the outer surface of the cylindrical body (Figs. 2-3). Wherein the anti-rotation lug comprises a flat, longitudinally disposed surface extending radially outwardly from the body outer surface, which is substantially perpendicular to the body of the vial. Moreover, the surface of the plurality of anti-rotation lugs is accessible when the cap 24 of combination container 14 is engaged with the neck of vial 12 (Fig. 4). Additionally, the lugs have a lowermost edge that is located closer to the open end than to the closed end (Fig. 2). Moreover, Brodner discloses a seal means 32 and 52 disposed between the body and the cap,

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which seals fluid within the container to assist in long term preservation of contents (Figs. 2-3).

Brodner does teach the vial comprising a identification markings 72 (column 1, lines 27-42, column 4, lines 4-10). However, Brodner does not specifically recite a first alignment marker on the body on the cap and a second alignment marker on the body, or the cap comprising a torque pattern with a plurality of radially disposed ribs.

Moore teaches a sample vial for use in an automated test apparatus comprising a body with an outer surface, an open end, a closed end, a cap 34 releasably engagable with the body. The cap comprising an outer surface and a torque pattern (Fig. 1 & 3) on the outer surface, wherein the torque pattern comprising a plurality of radially disposed ribs 64. The vial includes seals 54, 98 disposed between the body and the cap so as to be capable of forming a substantially fluid-tight seal therebetween. Moore teaches the cap comprising first screw threads 62 (Fig. 4) and a second mating screw thread 80 on the body (Fig. 1). Additionally, Moore teaches sample fluid level indicia 108 comprising an upper fill line and a lower fill line on the outer surface of the vial body (Fig. 1). Moore teaches a first alignment marker 110 on the body on the cap and a second alignment marker 108 on the body (column 7, lines 24-40). Moreover, Moore teaches a proximate structure comprising a storage container and vial sleeve 26 (Figs. 1-2).

Moore teach the creation of a fluid-tight seal formed between the body and the cap. However, neither Brodner nor Moore do disclose the specific range of torque between 5 and 50 inch-pound of torque applied to the cap. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have included in the invention of Brodner and Moore the range of torque between 5 and 50 inch-pound of torque applied to the cap in order to ensure the cap and vial are properly sealed and prevent the leakage of a sample or air from the

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vial. Further, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the invention of Brodner a first alignment marker on the cap and a second alignment marker on the body, as taught by Moore, in order to insure a fluid-tight seal after a predetermined amount of rotational movement has been achieved between the cap and the vial. Thereby preventing the possibility of damaging the seal by over tightening the cap (column 7, lines 24-34).

(11) Response to Argument

With regards to the rejection of claims 1-8, 10, 12-26 under 35 U.S.C. 103(a) as being unpatentable over Brodner (UPS 5,894,733) in view of Moore (USP 5,855,289), appellant argues that Brodner fails to disclose the cap 24 which is engageble with the sleeve structure 12, but rather the cap 24 is releasably engagable with the specimen container 10. Contrary to appellant's assertions, Examiner relies on the combination 14, comprising a both a sleeve 12 and an inner container 10, for the teaching of the sample vial having a body comprising: an outer surface 55, an open end and closed bottom end.

Additionally, appellant argues that the lowermost edge of ridges 56 are not perpendicular to the outer surface of the sleeve structure. Rather they appear tapered or beveled. Appellant contends that the lowermost edge of the anti-rotation lug 18 being substantially perpendicular to the outer surface of the body 12 of the instant invention is a relevant aspect of appellant's invention. Since it ensures that the vial 10 will not penetrate too deeply into bores 52, 62.

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Examiner does not agree this lowermost edge of the anti-rotation lug 18 being substantially perpendicular to the outer surface of the body 12 is a relevant aspect of appellant's invention, since the instant specification makes no mention of the anti-rotation lug 18 being substantially perpendicular to the outer surface of the body 12, but rather relies on Figures 1-2, 5 for support see page 4, 2nd and 3rd full paragraphs of the Response filed January 09, 2002. The specification simply discloses the purpose of the lugs 18 to prevent rotation of the body while inserted in the bore 52 of the tray. The bore 52 includes six ramps 56, each including a substantially vertical face 58 which abuts one of the body lugs 18, see page 13, lines 12-21. Additionally, the specification mentions that other materials, dimensions, and configurations for the body, cap, ribs, lugs and fluid level indicia and other features of the sample vial will be apparent to those skilled in the art, see specification, page 14, lines 14-18.

Additionally, appellant argues the lowermost edges of ridges 56 are not "substantially" perpendicular to the outer surface of the body. Examiner does not agree since, clearly, the lowermost ridges are "substantially" perpendicular (see Fig. 2 of Brodner). Moreover, appellant has not defined what constitutes "substantially" perpendicular anywhere in the instant specification. For example, is substantially perpendicular 85-95 degrees normal to the surface to the outer surface of the body? Appellant has not defined what is considered "substantially" perpendicular.

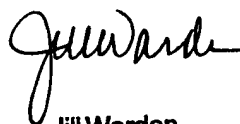
Appellant argues that the lowermost sleeve structure ridges 56 must be tapered, or beveled, for the Brodner device to properly operation, since perpendicular ridges would most likely abut against the uppermost edges of the tray ridges 68 when attempting to slide the sleeve structure 12 within the tray aperture 16. Examiner does not agree since Brodner comprises

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“substantially perpendicular” lugs 56 and obviously does not abut against the uppermost edges of the tray ridges 68 when placed within the tray aperture 16 (Fig. 4). Brodner does not teach the necessity of lugs 56 being tapered, or beveled, to function. Such a supposition by appellant is merely conjecture. Brodner disclose the small ridges 68 within aperture 62 simply producing a locking type action when the lugs 56 are in pressing engagement there against (column 3, lines 34-41). Which is not unlike the bore 52 of the instant invention comprising six ramps 56, each including a substantially vertical face 58 which abuts one of the body lugs 18, see page 13, lines 12-21 of the instant specification.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




Jill Warden
Supervisory Patent Examiner
Technology Center 1700

PKB
April 28, 2003

Conferees
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~~ROY KING~~ 

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